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William E. Player
Jacobson, Price, Holman & Stern, PLLC
400 Seventh Street, N.W.
Washington, D.C. 20004

In re Application of	:	
FORSSMANN, et al.	:	DECISION ON PETITION
U.S. Application No.: 09/582,107	:	
PCT No.: PCT/EP98/08405	:	UNDER 37 CFR 1.47(a)
Int. Filing Date: 22 December 1998	:	
Priority Date: 22 December 1997	:	
Attorney Docket No.: P65679US0	:	
For: INSULIN-LIKE GROWTH FACTOR BINDING	:	
PROTEIN FRAGMENTS AND THE	:	
UTILIZATION THEREOF	:	

This decision is in response to applicant's "Petition Under 37 CFR 1.47(a)" filed 11 January 2001.

BACKGROUND

On 22 December 1998, applicant filed international application PCT/EP98/08405, which claimed priority of an earlier application filed 22 December 1997. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 01 July 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 22 July 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 22 June 2000.

On 22 June 2000, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a translation of the International Application into English; a First Preliminary Amendment; an International Preliminary Examination Report and a copy of the first page of the published International Application. An oath or declaration as required by 35 U.S.C. 371 (c)(4) was not filed.

On 11 July 2000, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was also notified of the need to pay the \$130.00 surcharge for providing the oath or declaration later than 30 months from the earliest claimed priority date. Applicant was given

one month to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 10 August 2000, applicant responded by filing a combined declaration and power of attorney executed by inventors: Wolf-Georg Forssmann, Ludger Standker, Maik Obendorf, Lothar Kling and Hans-Georg Opitz. The combined declaration and power of attorney listed, but was not signed by joint inventor Hossein Mostafavi. Applicant provided payment of the appropriate surcharge.

On 21 August 2000, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) and a NOTIFICATION OF DEFECTIVE OATH OR DECLARATION (Form PCT/DO/EO/917) informing applicant of the need to provide an executed oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was given one month to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 11 January 2001, applicant responded with the present petition to accept the application absent the signature of joint inventor Hossein Mostafavi; a petition for extension of time and a check in the amount of \$945.00.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the requisite \$130 petition fee required by 37 CFR 1.17(I); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing joint inventor; and (4) an oath or declaration executed by each of the signing joint inventors on their behalf and on behalf of the non-signing joint inventor(s). Items 1, 3, and 4 above have been satisfied.

Regarding item 2 above, MPEP 409.03(d) provides, in part:

Where inability to find or reach a non-signing inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a non-signing inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. Such a petition will be dismissed as inappropriate.

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that

support a finding that the non-signing inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

Regarding the evidence provided by applicant, the second page of the declaration from Dr. Dohler is missing. The filed declaration contains points 1, 2 and 6, but not points 3, 4 and 5. In addition, it appears from the petition and two pages of the declaration filed that the single, unsuccessful attempt to provide the materials to Hossein Mostafavi is the only basis for applicant's argument that inventor Mostafavi can not be located. This is insufficient. Applicant must show that alternative means were employed, such as a search of telephone and/or Internet directories, in an attempt to locate Mr. Mostafavi.

In light of the above, applicant's petition cannot be granted.

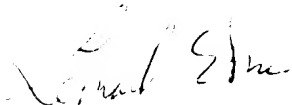
CONCLUSION

Applicant's petition under 37 CFR 1.47(a) is **DISMISSED, without prejudice.**

Applicant's included a check for \$945.00 and petition for extension of time. Applicants were required to provide the \$130.00 petition fee. As such, \$130.00 will be charged to Deposit Account No. 06-1358.

Applicants are hereby afforded TWO (2) MONTHS from the mail date of this decision to file either 1) an oath or declaration in compliance with 37 CFR 1.497 (a)-(b) signed by all inventors or 2) a renewed petition satisfying all requirements under 37 CFR 1.47(a). Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be directed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter directed to the attention of the PCT Legal Office.



Leonard Smith
Legal Examiner
PCT Legal Office



Derek A. Putonen
Petitions Attorney
PCT Legal Office
Tel: (703) 305-0130
Fax: (703) 308-6459